

REMARKS

1. Applicant thanks the Office for its remarks and observations, which have greatly assisted Applicant in responding.

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2. **35 U.S.C. § 101**

Claims 11-13 and 17-20 are rejected under 35 U.S.C. § 101 because the Claims are alleged to lack the necessary physical articles or objects to constitute a machine or manufacture within the meaning of the statute. Applicant amends
10 Claim 11 to provide structural elements sufficient to constitute a machine or manufacture within the meaning of the statute. The present rejection is therefore overcome.

3. **35 U.S.C. § 103**

15 Claims 1-3, 11-13 and 21-23 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. patent no. 6,529,267 ("Glerum") in view of U.S. patent no. 6,185,701 ("Marullo") and further in view of U.S. patent no. 6,918,066 ("Dutta") and U.S. patent application pub. no. 2007/0234217 ("Miller"). Applicant respectfully disagrees.

20 The Office relies on Marullo, page 8, lines 22-45 as teaching or suggesting "applying a browser test script, wherein said browser test script automatically instructs a first browser program containing said browser software to load and render web pages according to the list of URLs, wherein said browser test script tests said browser software over a plurality of applications at sites contained
25 within the list of URLs" There is no teaching or suggestion anywhere in Marullo of applying a browser test script that automatically instructs a browser program to load and render web pages. The cited portion of Marullo describes Marullo's webrunner subsystem, which is describes as "a virtual dynamic web browser for performing automated web server application verification and testing.

The application 30 exercises and verifies web server applications 32 and scripts by simulating a web browser using, in a conventional application, TCPIP sockets.” Col. 8, lines 24-29.

Accordingly, what is described by Marullo, is “a virtual browser application”
5 that automatically tests web servers and/or web applications. The Office may say that a “virtual browser” is a browser. However, this would be incorrect because, as Marullo teaches, the webrunner subsystem is a testing tool that replaces a browser in the web server application testing process, because, as Marullo also teaches at col. 2, lines 12 to 52, col. 3 lines 29-33 and col. 6, lines
10 55-59, the use of conventional browsers, even automatically driven, is unsuitable for the testing of web servers and web server applications. Marullo teaches that the use of a browser for testing web server application is unsuitable because it produces inconsistent results that are determined by the browser (col. 2, lines 25-27). In addition, Marullo teaches at col. 2, lines 22-27 that testing of a
15 browser application and testing of a web server application are distinct tasks, and that what is needed for web server testing is a software tool specifically tailored for web server application testing – not a conventional browser. Thus, the webrunner subsystem is not a browser itself, nor is it a test script that instructs a browser.

20 Marullo additionally teaches away from the use of live testers to manually test web server applications, at least at col. 2, lines 3-21, citing a number of problems: the slowness of the process, the difficulty of employing large numbers of testers, and the difficulty of testing a web server application thoroughly and consistently.

25 Accordingly, there is no teaching or suggestion in Marullo of “applying a browser test script, wherein said browser test script automatically instructs a first browser program containing said browser software to load and render web pages according to the list of URLs, wherein said browser test script tests said browser software over a plurality of applications at sites contained within the list of URLs.

30 ..”

As below, Glerum adds nothing to compensate for Marullo's deficiencies. The remaining references add nothing to Marullo. Dutta describes a method of testing a web server application on different browsers. However, the process, as described by Dutta, is at least partially manual, wherein the user must select a file or a web page and supply it to the browsers being used to perform the test. Additionally, there is no teaching or suggestion in Dutta of using a browser test script to test browser software over a plurality of applications at sites contained within the list of URLs. As previously mentioned, Dutta has nothing to do with testing browser software. Dutta is directed to testing web server applications. Additionally, it appears that Dutta can only test one web application at time. Dutta does not appear to be able to test browser software over a plurality of applications at sites contained within a list of URLs.

Nor does Miller add anything to compensate for Marullo's deficiencies. Miller is also directed to the testing of web site applications. While Miller automates iterative testing of a single web application, there is no teaching or suggestion in Miller of "applying a browser test script, wherein said browser test script automatically instructs a first browser program containing said browser software to load and render web pages according to the list of URLs, wherein said browser test script tests said browser software over a plurality of applications at sites contained within the list of URLs. . . ."

Accordingly, there is no teaching in the combination of "applying a browser test script, wherein said browser test script automatically instructs a first browser program containing said browser software to load and render web pages according to the list of URLs, wherein said browser test script tests said browser software over a plurality of applications at sites contained within the list of URLs. . . ."

The Office relies on Glerum as teaching or suggesting "detecting one or more errors in rendering of said first browser program using the web pages" Applicant respectfully disagrees. There is no teaching or suggestion whatsoever in Glerum of detecting a browser's rendering errors. Glerum

describes a method and system for reporting program failures. Glerum defines program failures as either crashes or set-up failures. Col. 2, lines 5-6. In addition, Glerum describes that the system also reports a “problem encountered during in-house testing of a program module.” However, the only example
5 Glerum provides of such a testing problem is at col.8, lines 61-63 – asserts. Accordingly, it is incorrect that Glerum teaches or suggests “detecting one or more errors in rendering of said first browser program using the web pages”

The remaining references add nothing to compensate for Glerum’s deficiencies. All three of the remaining references are directed to testing of web
10 server applications, rather than browser testing. The remaining references therefore do not concern themselves with detecting rendering errors that result from browser defects. Accordingly, there is no teaching in the combination of “detecting one or more errors in rendering of said first browser program using the web pages”

15 The Office relies on Dutta, col. 7, lines 23-35 and lines 50-65 as teaching or suggesting “wherein a representation of rendering results of a browser program comprises an internal representation of a web page as interpreted by the browser program. As Applicant has previously argued, the scorecard parameters described represent performance criteria for the web page:

20 “The next step 62 is to establish the rules to generate a scorecard for evaluating a web site.” Col 8, lines 32-33 (emphasis added);

“This scorecard will be the criteria on which the web site will be evaluated for effectiveness on the different web browsers chosen by the web designer.” Col. 8, lines 33-36 (emphasis added); and

25 “This step also evaluates the web page for each selected browser using the scorecard rules generated in step 62.” Col 8, lines 43-44 (emphasis added).

Furthermore, during the evaluation process,” [t]he web designer will have an opportunity to edit the web page if the designer is not satisfied with the web design.” Col. 8, lines 52-53. Thus, as described in Dutta, what is being

evaluated is the web site, and not the browser. As taught in Marullo, web site evaluation and web browser evaluation are distinct tasks requiring different tools. They are not indistinguishable or interchangeable, as the Office has previously maintained. Dutta's system has nothing to do with tracking browser rendering errors. Dutta's scorecard, as amply demonstrated above, has nothing to do with tracking browser errors. It is configured for assessing deficiencies of the web site – which, as Marullo teaches, is an entirely different task from evaluating the web browser.

Additionally, the ordinarily-skilled practitioner would have no motivation to combine the teachings of Marullo/Glerum and Dutta because Dutta's method is largely under human control and is performed on an individual web server application. As above, Marullo explicitly criticizes human-driven testing as being overly time-consuming, expensive, inconsistent and lacking in thoroughness. Accordingly, the ordinarily-skilled practitioner would not be lead to Dutta to remedy the deficiencies of Marullo/Glerum.

The Office relies on Miller, §§ 0024, 0082-0083, 0088-0094 as teaching or suggesting:

“wherein the internal representation includes a list of objects to be displayed for the web page and the attributes of the objects and wherein the attributes and the objects that are uniquely defined by the web page are compared to ensure that there is no glitch in interpreting the information defining the web page”

While the cited paragraphs from Miller appear to resemble the claimed subject matter, the fact remains that Miller is directed to cataloging deficiencies of a web application, which as Marullo has established, is a separate and distinct task from evaluating a browser. There is no teaching or suggesting anywhere in Miller that any step of Miller's methodology is directed to detecting browser rendering errors.

In view of the foregoing, the combination Glerum/Marullo/Dutta/Miller fails to teach or suggest all elements of Claim 1. To establish *prima facie*

obviousness of a claimed invention, all the claim features must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974) (emphasis added). In fact, the Board of Patent Appeal and Interferences has recently confirmed that a proper obviousness determination requires that an
5 Examiner make “a searching comparison of the claimed invention – *including all its limitations* – with the teaching of the prior art.” *In re Wada and Murphy*, Appeal 2007-3733, *citing In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995).

Additionally, the combination is improper because the Office cites no motivation for combining the teachings of Marullo and Glerum. The Office is
10 respectfully reminded that, even in the post-*KSR* climate, establishing *prima facie* obviousness requires that the Office identify a motivation that for combining the reference teachings.

Thus, the Office has failed to establish *prima facie* obviousness of the claimed subject matter. The present rejection of Claim 1 is therefore improper.

In spite of the foregoing, in the interest of describing the claimed subject matter more clearly, Applicant amends Claim 1 to describe “detecting one or more browser rendering errors of said first browser program.” Support for the amendment is explicit in Claim 1. The amendment merely states more clearly what was already explicitly described in Claim 1. As Applicant has amply demonstrated, there is no teaching or suggestion in the combination of a method of testing browser software in a computer environment that includes the steps of:

“generating a list of URLs (Universal Resource Location) using a web crawler;

15 applying a browser test script, wherein said browser test script automatically instructs a first browser program containing said browser software to load and render web pages according to the list of URLs, wherein said browser test script tests said browser software over a plurality of applications at sites contained within the list of URLs;

20 detecting one or more browser rendering errors of said first browser program using the web pages by comparing a representation of rendering results

of the first browser program to a representation of rendering results of a second browser program, wherein a representation of rendering results of a browser program comprises an internal representation of a web page as interpreted by the browser program, wherein the internal representation includes a list of objects to be displayed for the web page and the attributes of the objects, and wherein the attributes and the objects that are uniquely defined by the web page are compared to ensure that there is no glitch in interpreting the information defining the web page; and

wherein one or more errors are detected when the representation of rendering results of the first browser program does not match the representation of rendering results of the second browser program; and

automatically storing information about said one or more errors;

wherein said step of applying a browser test script is performed while said first browser program is under development and prior to distribution.” The present rejection is therefore deemed improper/overcome. Claim is therefore allowable over the cited combination of teachings.

The foregoing remarks apply equally to Claims 11 and 21. Claims 11 and 21 are amended in similar fashion to claim 1. Claims 11 and 21 are therefore deemed allowable for the same reasons that Claim 1 is allowable.

In view of their dependence from allowable parent claims, the dependent claims are deemed allowable without any separate consideration of their merits. Nevertheless, Applicant has the following comments regarding the dependent claims:

Claims 7, 17, and 27 are rejected as being unpatentable over Glerum in view of Marullo and further in view of Dutta and further in view of Miller and further in view of Castro. Applicant respectfully disagrees.

Applicant first notes the multiplicity of references upon which the present rejection is based. While the relevant legal precedent sets no limit on the number of references that can be combined to establish *prima facie* obviousness, the unwieldiness of the present combination and the contrived, meandering

nature of the chain of motivation the Office cites in support of the combination raises a strong suggestion that hindsight was improperly used to assemble the teachings, using the Claims as a template, to establish *prima facie* obviousness. In rebuttal, the Office will cite *In re McLaughlin* for the proposition that a certain amount of hindsight in the examination process is inevitable. However, there is ample legal precedent that has not been overruled that establishes that use of hindsight to establish *prima facie* obviousness is improper.

Additionally, Castro has nothing to do with an internal representation of a web page. Rather Castro is describing web page attributes as they are found in the source code for the page. Accordingly, even if the parent claims had not been amended, the present rejection would be improper.

Claims 8, 18 and 28 are rejected as being unpatentable over Glerum in view of Marullo and further in view of Dutta and further in view Miller and further in view of U.S patent no. 6,865,592 ("Shindo"). Again, the multiplicity of references upon which the present rejection is based raises a strong suggestion
5 of improper hindsight.

Nevertheless, in view of the foregoing amendments, the present rejection is deemed overcome.

Claims 9-10, 19-20 and 29-30 are rejected as being unpatentable over Glerum in view of Marullo and further in view of Dutta and further in view of Miller
10 and further in view of Garcia-Chiesa. The above remarks regarding the multiplicity of references apply equally to the present rejection. Nevertheless, in view of the foregoing amendments, the present rejection is deemed overcome.

4. The above amendments are made for expediency's sake, in deference to
15 the Office policy of compact prosecution. They do not constitute agreement with the Examiner's position, nor do they reflect intent to sacrifice claim scope. Applicant expressly reserves the right to pursue patent protection of a scope it reasonably believes it is entitled to in one or more further submissions to the

USPTO.

5. For the record, Applicant respectfully traverses any and all factual assertions in the file that are not supported by documentary evidence. Such include assertions based on findings of inherency, assertions based on official notice, and any other assertions of what is well known or commonly known in the prior art.

CONCLUSION

10 In view of the foregoing, the application is deemed to be in allowable condition. Applicant therefore requests reconsideration and prompt allowance of the claims. Should the Examiner have any questions concerning the Application, he is urged to contact Applicant's attorney at (650) 474-8400.

15 Respectfully submitted,



Michael A. Glenn

Reg. No. 30,176

20 Customer No. 22862